

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 61

Filed by: Trial Section Merits Panel

Mail Stop Interference
P.O. Box 1450
Alexandria, VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JEANNE DIETZ-BAND,
WANG-TING HSIEH, and JOHN F. CONNAUGTON

Junior Party,
(Patent 6,414,133),

v.

JOE W. GRAY,
DANIEL PINKEL, and DOUGLAS TKACHUK

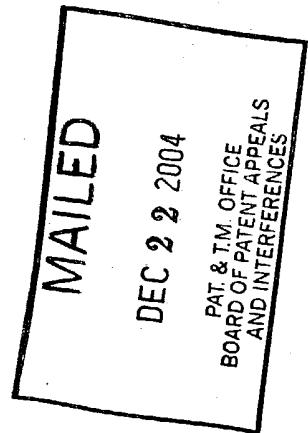
Senior Party,
(Application 10/608,092).

Patent Interference No. 105,208

Before McKELVEY, Senior Administrative Patent Judge, and TORCZON and LANE,
Administrative Patent Judges.

LANE, Administrative Patent Judge.

JUDGMENT-Bd. R. 127(b)



Background

The following papers were filed on 8 December 2004:

- (1) A paper entitled "DIETZ-BAND NOTICE OF SETTLEMENT AGREEMENT" (Paper 56);
- (2) A paper entitled "DIETZ-BAND REQUEST FOR ENTRY OF ADVERSE JUDGMENT" (Paper 57);
- (3) A paper entitled "GRAY REQUEST TO WITHDRAW MOTIONS AND OPPOSITIONS" (Paper 58); and
- (4) A paper entitled "DIETZ-BAND REQUEST FOR DISMISSAL OF DIETZ-BAND PRELIMINARY MOTIONS 1-8" (Paper 59).

It appears that the parties have settled the interference and now each wishes to either withdraw (Gray) or have dismissed (Dietz-Band) the motions it has filed. Moreover, Dietz-Band has requested adverse judgment on the basis that its involved claims are unpatentable "under 35 USC § 102(b) over Cassell, M.J., *et al.*, *Hum. Reprod.* 12:2019-2027 (1997) (Gray Exhibit 1015)". (Paper 57 at 2).

An interference is declared to assist the patent examiner in determining whether an application can be allowed notwithstanding a patent claiming interfering subject matter. If we enter judgment against the involved claims of Dietz-Band, then the Dietz-Band patent is no longer an impediment to the examiner allowing Gray's application.¹ Thus, in these particular circumstances, granting Dietz-Band's request for judgment against its involved claims is in the interest of securing a just, speedy, and inexpensive resolution of the interference. Bd. R. 41.1(b)

¹ Dietz-Band is junior party and thus is not 35 USC § 102(e) prior art to Gray.

Because there is no need to continue the interference, there appears to be no need to decide the motions filed by the parties. Moreover, neither party wishes us to decide the motions. Accordingly, we dismiss Dietz-Band motions 1 through 8 (Papers 29, 30, and 39-44) and Gray motions 1 through 3 (Papers 49-51).

Recommendation

A judgment may include a recommendation for further action by the examiner. 37 CFR § 41.127(c). (Bd. R. 127(c)). In accordance with Bd. R. 127(c), upon the resumption of ex parte prosecution of the Gray application, it is recommended that the examiner consider:

- (1) Dietz-Band motion 1 for judgment that the involved Gray claims are unpatentable under 35 USC § 112, ¶ 1, for lack of written description (Paper 29) and Gray's opposition to the motion (Paper 35), and
- (2) Dietz-Band motion 2 for judgment that the involved Gray claims are unpatentable under 35 USC § 112, ¶ 1, for lack of an enabling disclosure (Paper 30) and Gray's opposition to the motion (Paper 36).

After reviewing Dietz-Band motions 1 and 2 and Gray's oppositions to the motions, the examiner may take such action as the examiner deems appropriate.

Order

Upon consideration of the record of the interference and for reasons given, it is

ORDERED that Dietz-Band's request for adverse judgment is GRANTED;

FURTHER ORDERED that JEANNE DIETZ-BAND, WANG-TING HSIEH,

and JOHN F. CONNAUGTON is not entitled to a patent containing claims 1-3, 5-12, and 14-19

of US patent 6,414,133 issued 2 July 2002, which correspond to count 1, the sole count in the interference;

FURTHER ORDERED that a copy of this judgment be given a paper number and be entered in the administrative records of each of Dietz-Band's 6,414,133 patent and Gray's 10/608,092 application;

FURTHER ORDERED that Dietz-Band motions 1 through 8 and Gray motions 1 through 3 are DISMISSED; and

FURTHER ORDERED that a recommendation is made under 35 USC § 41.127(c) that, upon the resumption of ex parte prosecution of the Gray application, the examiner consider:

- (1) Dietz-Band motion 1 and Gray's opposition to the motion, and
- (2) Dietz-Band motion 2 and Gray's opposition to the motion,

and take any action that would be appropriate in view of the motions and oppositions.

cc (via facsimile and first class mail):

Attorney for Dietz-Band (real party in
interest: Ventana Medical Systems, Inc.):

Jorge A. Goldstein, Esq.
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934

Fax: 202-371-2540

Attorney for Gray:

R. Danny Huntington, Esq.
BURNS, DOANE, SWECKER & MATHIS LLP
1737 King Street, Suite 500
Alexandria, VA 22314

Fax: 703-836-2021